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10/604,853

08/21/2003

Randall A. Addington

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09/30/2008

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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL A. ADDINGTON, ROBERT W. ADDINGTON, and
ROBERT W. ADDINGTON, II

Application No. 10/604,853
Technology Center 3700

Mailed: September 30, 2008

Before DALE M. SHAW, *Chief Appeals Administrator*
SHAW, *Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 14, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER

The Examiner's Answer (mailed September 13, 2007) cites U.S. Patent 3,728,736 (Pugh) and Non-Patent Literature "*The First Instrumented Bowling Ball*" under the heading "(9) Grounds of Rejection." These references *were not* included under Section "(8) Evidence Relied Upon" as required. Before further review, the Examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of references mentioned in the statement of rejections. *See the Manual of Patenting Examining Procedure (MPEP)* § 1207.02. Further review of the Answer reveals that the Examiner in section (2) lists U.S. Patent Applications 09/396,530 and 09/396,531 as copending applications, having a Board Decision on February 28, 2007 and an Appeal Brief filed on June 4, 2007, respectively. Then the Examiner goes on to state in Section (11) that no decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interference section of the Examiner's Answer. The Examiner is hereby required to amend the Related Appeals and Interferences section by listing 09/396,530 (Appeal No. 2006-3338) and providing a copy of the Board Decision as required by *the Manual of Patent Examining Procedure (MPEP)* § 1207.02(A)(11).

APPEAL BRIEF

The Appeal Brief (received by the USPTO on October 31, 2005) fails to include two required headings:

EVIDENCE APPENDIX as required by 37 C.F.R. § 41.37(c)(1)(ix); and the

RELATED PROCEEDINGS APPENDIX as required by 37 C.F.R. § 41.37(c)(1)(x). Correction is required.

REPLY BRIEF

The Reply Brief (received by the USPTO on September 24, 2007) contains new reference evidence (US Patent 4,371,163 (Shaffer et al.)) which deems the Reply Brief non-compliant. *See* MPEP § 1208(a)(2). The Examiner must send out a corrected response to the Reply Brief informing Appellants of such. *See* MPEP § 1208(b). Correction is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- (1) to issue and mail a PTOL-90 having the missing references listed under the section (8) of the Examiner's Answer, and to amend section (11) of the Examiner's Answer in accordance with the above instruction;
- (2) to instruct Appellants to provide a Supplemental Appeal Brief which fully complies with 37 C.F.R. §§ 41.37 (c)(1)(ix), and (c)(1)(x);
- (3) to send out a corrected response to the non-compliant Reply Brief received September 24, 2007; and
- (4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/hh

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